



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/666,129

09/22/2003

Osamu Munkata

1051

8406

27649

7590

06/22/2006

MICHAEL TOBIAS

#40

1717 K ST. NW, SUITE 613
WASHINGTON, DC 20036

EXAMINER

IP, SIKYIN

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,129

Applicant(s)

MUNEKATA ET AL.

Examiner

Sikyin Ip

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-31 is/are pending in the application.
- 4a) Of the above claim(s) 20-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/175,149.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I, claims 12-19, in the reply filed on April 12, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 12-16 are rejected under 35 U.S.C. 103(a) as obvious over JP08001373.

JP08001373 discloses Pb-free Sn based solder alloy overlapped claimed Sn based solder composition (abstract). Forming the solders of cited references into a solder paste is contemplated within ambit of ordinary skill artisan. Therefore, the subject

Art Unit: 1742

matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the subject matter disclosed by the reference. Overlapping ranges have been held to be a prima facie case of obviousness. See *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974). An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties. *In re Gyurik*, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See *In re May*, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and *In re Hoch*, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). Because of the close structural similarity between the claimed compounds at issue here and the compounds of cited reference and because those prior art compounds possess claimed activity, it is concluded that the required motivation is present here. See *In re Wood*, 582 F.2d 638, 641, 199 USPQ 137, 139 (CCPA 1978). When prior art compounds essentially "bracketing" the claimed compounds in structural similarity are all known, one of ordinary skill in the art would clearly be motivated to make those claimed compounds in searching for new products. Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the subject matter disclosed by the reference.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08001373 as applied to claims 12-16 above, and further in view of USP 4858816 to

Art Unit: 1742

Gontier.

The claimed subject matter as is disclosed and rejected above by the Sato or JP 08001373 except for the using Sn based solder in wave soldering. However, Gontier in col. 2, lines 10-31 discloses tin wave soldering is known in the same field of endeavor or the analogous metallurgical art. It has been held a use of new material (here the solders are known) in old patented process is not invention since process is merely being used with analogous material in same art for which process was developed, In re LaVerne, et al., 108 USPQ 335. Therefore, it would have been prima facie obvious for ordinary skill artisan motivated by a reasonable expectation of success to wave soldering with conventional Sn based solder alloy in order to obtain all of the known benefits.

Response to Arguments

Applicant's arguments filed January 28, 2004 and declaration filed March 21, 2005 have been fully considered but they are not persuasive.

Applicant's arguments with respect to Sato and claims 12-19 have been considered but are moot in view of the new ground(s) of rejection.

Applicants' argument with respect to combine of two cited references is noted. But, applicants fail to provide reason why Sn based solder from cited reference is excluded from Sn based solder as taught by Gontier.

Applicants' Exhibit 1 (sales record) in declaration is noted. But, there is no evidence the sales are solely because of the solder composition.

Art Unit: 1742

Exhibit 1 (wetting time) in declaration is noted. But P is essential element in newly cited JP 08001373 solder.

Exhibits 2 and 3 in declaration are noted. But according to the paragraph bridging pages 7-8 in specification as original filed that wetting time and zero-cross time in Exhibits 2 and 3 respectively are considered "good" not "excellent". Assuming arguendo that the P content between 0.01 and 0.02 wt.% is acceptable as set forth in declaration, paragraph 18, but said content is not commensurate with the scope of instant claims. MPEP § 716.02(d), *In re Tiffin*, 448 F.2d 791, 792 (Fed. Cir. 1971), *In re Coleman*, 205 USPQ 1172, *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983), and *In re Greenfield*, 197 USPQ 227. Moreover, applicants failed to provide literal support of 0.02 wt.% in the specification originally filed. The property or result relied upon must be disclosed in the specification or flow naturally from the teaching of the specification. *In re Slocombe*, 184 USPQ 740, 743 and *In re Davies and Hopkins*, 177 USPQ 381 (CCPA 1973).

Conclusion

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made

Art Unit: 1742

to the disclosure. See 37 C.F.R. § 1.121; 37 C.F.R. Part §41.37 (c)(1)(v); MPEP §714.02; and MPEP §2411.01(B).


Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (571)-272-1244.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
June 19, 2006